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Dated: April 12, 2013
Electronic Signature for Paul B. Stephens: /Paul B. Stephens/

Docket No.: 30275/939A
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Gerard Mourou

Application No.: 09/775,106

Confirmation No.: 4544

Filed: February 1, 2001

Art Unit: 3742

For: METHOD FOR CONTROLLING CONFIGURATION
OF LASER INDUCED BREAKDOWN AND ABLATION

Examiner: G. S. Evans

PETITION PURSUANT TO 37 CFR §1.183

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant files this petition, under 37 CFR §1.183, requesting that the Director, or the Director's designee, suspend and/or waive the guidelines of MPEP 1449.01(B), which have been applied by the examiner in rejecting the claims of the present application in view of a prior copending reexamination application on a related, but different application. The guidelines in MPEP 1449.01(B) did not exist during the co-pendency between that reexamination application and the instant application, but rather were promulgated after; nor were those guidelines followed by the Office during the co-pendency of that reexamination application. Retroactive application of these guidelines is improper.

I. **Statement of Facts (“SoF”)**

1. The above-captioned patent application is one of three applications to reissue U.S. Patent No. 5,656,186.
2. The ‘186 patent issued (with 45 claims) April 12, 1997, from U.S. Serial No. 08/224,961 filed April 8, 1994.
3. More than two years after the ‘186 patent issued, and on August 4, 1999, an application (U.S. Serial No. 09/366,685) to reissue the ‘186 patent was filed.
4. The ‘685 reissue application eventually issued as U.S. Patent No. RE37,585 on March 19, 2002.
5. Prior to issuance of the ‘585 patent, and on February 1, 2001, the above-captioned application (also termed herein the “instant application”) and U.S. Serial No. 09/775,069 were filed claiming priority to the ‘685 reissue application pursuant to 35 USC § 120.
6. The ‘106 and ‘069 applications were filed as divisions of the ‘685 reissue application.
7. On June 25, 2004, the Patent Office granted a third-party request for ex parte reexamination of the ‘585 patent, under reexamination No. 90/007,102, which eventually issued as U.S. Patent No. RE37,585 F1, Reexamination Certificate (5685th) (hereinafter the “reexamination certificate”) on March 6, 2007.
8. Both of the ‘069 and above-captioned application are currently pending. Both applications were copending with the ‘102 reexamination application during the period beginning June 25, 2004, and ending March 6, 2007 (hereinafter the “copending period”)
9. On January 13, 2012, the Patent Office issued a non-final action rejecting claims 46-50, 52-54, 56-66, 68-80, and 106-113, for the first time, as reciting subject matter that is:
 - a. allowable in view of the prior art; but
 - b. impermissibly broader than subject matter recited in claims confirmed in the reexamination certificate, in contravention of MPEP § 1449.01(B).

10. On June 25, 2012, Applicant filed a response indicating that (i) MPEP § 1449.01(B) did not exist during the copending period, (ii) the guidelines of MPEP § 1449.01(B) were not followed during the copending period and (iii) it was, therefore, improper to apply MPEP § 1449.01(B) in rejecting the claims of the instant application.
11. On, September 25, 2012, the Patent Office issued a final action maintaining the rejection of the claims under MPEP § 1449.01(B) and again confirming that the claims, otherwise recite allowable subject matter.
12. MPEP § 1449.01(B) is from a section of MPEP § 1449.01 entitled “Reexamination Certificate Is To Be Issued for a Patent, While a Reissue Application for the Patent Is Pending” (see, *Ex. A*) that states, in part:
 - a. “The following provides guidance to address the situation where a reexamination certificate is to be issued for a patent, while a reissue application for the patent is pending and will not be merged with the reexamination. This can occur, for example, where a reissue application prosecution is stayed or suspended, and the prosecution of a reexamination proceeding for the patent (for which reissue is requested) is permitted to proceed. It can also occur where a reissue application is filed after the reexamination proceeding has entered the publication process, such that it is too late to consider the question of stay or merger.” MPEP § 1449.01(B) (Eighth Edition, Revision 9)
 - b. MPEP § 1449.01(A) (Eighth Edition, Revision 9) instructs:
 - i. “The examiner will not act on the reissue application until the reexamination certificate issues and publishes.” (Emphasis added)
 - c. MPEP § 1449.01(B) (Eighth Edition, Revision 9) instructs:
 - i. “After the reexamination certificate issues and publishes--At the time that the reexamination certificate is issued and published, the Office will resume examination of the reissue application--”
13. The text from MPEP § 1449.01(B), cited in the preceding paragraph (see, *Ex. A*) appears nowhere in the following revisions to the MPEP, Eighth Edition:

- a. Revision 2, published May 2004;
 - b. Revision 3, published August 2005;
 - c. Revision 4, published October 2005;
 - d. Revision 5, published August 2006; and,
 - e. Revision 6, published September 2007.
14. MPEP § 1449.01(B) first appeared in Revision 7 of the MPEP Eighth Edition, which the Patent Office published in July 2008, and which publication occurred:
- a. After the instant application and the '102 reexamination application were filed,
 - b. After the reexamination certificate issued; and,
 - c. After the copending period.
15. During the copending period, MPEP § 1449.01 stated that the Patent Office could only (i) merge prosecution of a reexamination application and a copending reissue application, or (ii) stay prosecution of one application until prosecution on the other is complete:
- a. 37 CFR 1.565(d) provides that if “a reissue application and an ex parte reexamination proceeding on which an order pursuant to 37 CFR 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings.” 37 CFR 1.991 provides that if “a reissue application and an inter partes reexamination proceeding on which an order pursuant to 37 CFR 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings”. If an examiner becomes aware that a reissue application and an ex parte or inter partes reexamination proceeding are both pending for the same patent, he or she should >immediately< inform the Technology Center (TC) >or Central Reexamination Unit (CRU)< Special Program Examiner (SPRE) immediately. MPEP § 1449.01 (Eighth Edition, Rev. 2-6, where the >inserted< changes were added in Rev. 5, August 2006)

16. MPEP § 1449.01 (Eighth Edition, Rev. 2, May 2004) instructed that when “a reissue application and a reexamination proceeding are pending concurrently on a patent, and an order granting reexamination has been issued for the reexamination proceeding, *the files for the reissue application and the reexamination will be forwarded to the Office of Patent Legal Administration (OPLA) for a decision whether to merge the reissue and the reexamination, or stay one of the two.*” (Emphasis added).
17. MPEP § 1449.01 (Eighth Edition, Rev. 5, August 2006 & Rev. 6, September 2007) instructed that when “[w]here a reissue application and a reexamination proceeding are pending concurrently on a patent, *and an order granting reexamination has been issued* for the reexamination proceeding, the Office of Patent Legal Administration (OPLA) must be notified that the proceedings are ready for a decision as to whether to merge the reissue and the reexamination, or stay one of the two.”
18. The Office knew of the ‘102 reexamination application during the copending period.
19. MPEP § 1449.01 (Eighth Edition, Rev. 2, May 2004) instructed, for example, that when “[w]here a reissue application and a reexamination proceeding are pending concurrently on a patent, the patent owner, i.e., the reissue applicant, has a responsibility to notify the Office of the concurrent proceeding. 37 CFR § 1.178(b), 37 CFR 1.565(a), and 37 CFR 1.985(a).”
20. During the copending period, and specifically on October 28, 2004, the patent owner notified the Office of the concurrent ‘102 reexamination application, via a Supplemental Information Disclosure Statement (*Ex. B*).
21. However, there is no indication in the file wrapper of the instant application or that of the copending ‘069 application that the OPLA was notified by the examiner for a decision on whether to merge these cases with the ‘102 reexamination application, as required by MPEP § 1449.01 (Eighth Edition, Rev. 2, May 2004).

22. During the prosecution of the '102 reexamination application, the Office did not act as though the claims in the above-captioned application or the other '069 application would be estopped or considered as potentially surrendered based on the prosecution of the claims in the '102 reexamination application.
23. The Office did not merge or stay the prosecution of either the present application or the copending '069 application with that of the '102 reexamination application.
24. Further, the Office did not order the reissue patent applicant/patent owner to place and maintain in a single application all claims that may have been pending in the other two applications (as there was no merged proceeding). Cf. 37 CFR §1.565(d).
25. Instead, the Office continued with separate prosecution of the instant application during the copending period, issuing a final office action, on April 12, 2005 and a non-final office action (after filing of an RCE), on June 21, 2006.
26. In short, the guidelines of MPEP § 1449.01(B) did not exist during the copending period.
27. And the guidelines of MPEP § 1449.01(B) were not followed during the copending period.
28. The claims in the '102 reexamination application were not the same as those pending in the instant application or those in the copending '069 application.
29. Claims having the same scope as those of the instant application (or that of the copending '069 application) were not canceled during the '102 reexamination application.
30. The claims of the instant application (and that of the copending '069 application) are different from the claims prosecuted in the '102 reexamination application.
31. The Patent Owner did file a terminal disclaimer in the above-captioned case, disclaiming any patent term beyond that of RE 37,585, which is the separate reissue application upon which the '102 reexamination application was filed.

That terminal disclaimer, however, was filed on January 28, 2003, before the grant (and filing) of the '102 reexamination application.

32. The Office has never issued an double patenting rejection between the claims of RE37,585 F1 and those of the instant application.
33. The only doubling patenting rejection in the file wrapper came after completion of the '102 reexamination application; and that double patenting rejection was between the instant application and the copending '069 application.
34. MPEP § 1449.01(B) does not govern the instant application. No surrender or estoppel exists between the non-merged and non-stayed '102 reexamination application and the instant application, under in MPEP 1449.01(B) or otherwise.
35. The use of MPEP 1449.01(B) to reject the claims under 35 U.S.C. § 251 is procedurally improper.
36. Applicant asks that the Director suspend and/or waive the guidelines of MPEP 1449.01(B) as not applicable to the instant application.

II. Requested Relief

Applicant respectfully requests that the Director, or the Director's designee, suspend and/or waiver the guidelines of MPEP 1449.01(B) in regards to the instant application. Those guidelines were not in place over the relevant time frame. And those guidelines were not followed by the Office during that relevant time frame. To use the current guidelines under MPEP 1449.01(B) to reject the pending reissue application claims as surrendered, well after the relevant time frame, is an extraordinary situation. This petition is accompanied by the petition fee set forth in 37 CFR § 1.17(h).

In the event the Director determines that this petition should more properly be considered under 37 C.F.R. § 1.181, Applicant respectfully requests the Director treat this petition under that later section, instead.

In any event, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 13-2855, under Order No. 30275/939A.

III. Reasons for Granting the Requested Relief

The above-captioned patent application is one of three applications to reissue U.S. Patent No. 5,656,186. *SoF 1.* The '186 patent issued (with 45 claims) April 12, 1997, from U.S. Serial No. 08/224,961 filed April 8, 1994. *SoF 2.* More than two years after the '186 patent issued, and on August 4, 1999, an application (U.S. Serial No. 09/366,685) to reissue the '186 patent was filed. *SoF 3.* The '685 reissue application eventually issued as U.S. Patent No. RE37,585 on March 19, 2002. *SoF 4.*

Prior to issuance of the '585 patent, and on February 1, 2001, the above-captioned application (also termed herein the "instant application") and U.S. Serial No. 09/775,069 were filed claiming priority to the '685 reissue application pursuant to 35 USC § 120. *SoF 5.* The '106 and '069 applications were filed as divisions of the '685 reissue application. *SoF 6.*

On June 25, 2004, the Patent Office granted a third-party request for ex parte reexamination of the '585 patent, under reexamination No. 90/007,102, which eventually issued as U.S. Patent No. RE37,585 F1, Reexamination Certificate (5685th) (hereinafter the "reexamination certificate") on March 6, 2007. *SoF 7.*

Both of the '069 and above-captioned application are currently pending. Both applications were copending with the '102 reexamination application during the period beginning June 25, 2004, and ending March 6, 2007 (hereinafter the "copending period"). *SoF 8.*

On January 13, 2012, the Patent Office issued a non-final action rejecting claims 46-50, 52-54, 56-66, 68-80, and 106-113, for the first time, as reciting subject matter that is: a. allowable in view of the prior art; but, b. impermissibly broader than subject matter recited in claims confirmed in the reexamination certificate, in contravention of MPEP § 1449.01(B). *SoF 9.*

On June 25, 2012, Applicant filed a response indicating that (i) MPEP § 1449.01(B) did not exist during the copending period, (ii) the guidelines of MPEP § 1449.01(B) were not

followed during the copending period and (iii) it was, therefore, improper to apply MPEP § 1449.01(B) in rejecting the claims of the instant application. *SoF 10*. On, September 25, 2012, the Patent Office issued a final action maintaining the rejection of the claims under MPEP § 1449.01(B) and again confirming that the claims, otherwise recite allowable subject matter. *SoF 11*.

MPEP § 1449.01(B) is from a section of MPEP § 1449.01 entitled “Reexamination Certificate Is To Be Issued for a Patent, While a Reissue Application for the Patent Is Pending” (see, *Ex. A*) that states, in part: a. “The following provides guidance to address the situation where a reexamination certificate is to be issued for a patent, while a reissue application for the patent is pending and will not be merged with the reexamination. This can occur, for example, where a reissue application prosecution is stayed or suspended, and the prosecution of a reexamination proceeding for the patent (for which reissue is requested) is permitted to proceed. It can also occur where a reissue application is filed after the reexamination proceeding has entered the publication process, such that it is too late to consider the question of stay or merger.” MPEP § 1449.01(B) (Eighth Edition, Revision 9), b. MPEP § 1449.01(A) (Eighth Edition, Revision 9) instructs: i. “The examiner will not act on the reissue application until the reexamination certificate issues and publishes.” (Emphasis added) c. MPEP § 1449.01(B) (Eighth Edition, Revision 9) instructs: i. “After the reexamination certificate issues and publishes--At the time that the reexamination certificate is issued and published, the Office will resume examination of the reissue application--”. *SoF 12*.

The text from MPEP § 1449.01(B), cited in the preceding paragraph (see, *Ex. A*) appears nowhere in the following revisions to the MPEP, Eighth Edition: Revision 2, published May 2004; Revision 3, published August 2005; Revision 4, published October 2005; Revision 5, published August 2006; or Revision 6, published September 2007 (the applicable MPEP revisions over the copending period. *SoF 13*.

MPEP § 1449.01(B) first appeared in Revision 7 of the MPEP Eighth Edition, which the Patent Office published in July 2008, and which publication occurred: a. After the instant application and the ‘102 reexamination application were filed, b. After the reexamination certificate issued; and, c. After the copending period. *SoF 14*.

During the copending period, MPEP § 1449.01 stated that the Patent Office could only (i) merge prosecution of a reexamination application and a copending reissue application, or (ii) stay prosecution of one application until prosecution on the other is complete: a. 37 CFR 1.565(d) provides that if “a reissue application and an ex parte reexamination proceeding on which an order pursuant to 37 CFR 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings.” 37 CFR 1.991 provides that if “a reissue application and an inter partes reexamination proceeding on which an order pursuant to 37 CFR 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings”. If an examiner becomes aware that a reissue application and an ex parte or inter partes reexamination proceeding are both pending for the same patent, he or she should >immediately< inform the Technology Center (TC) >or Central Reexamination Unit (CRU)< Special Program Examiner (SPRE) immediately. MPEP § 1449.01 (Eighth Edition, Rev. 2-6, where the >inserted< changes were added in Rev. 5, August 2006). *SoF 15.*

MPEP § 1449.01 (Eighth Edition, Rev. 2, May 2004) instructed that when “a reissue application and a reexamination proceeding are pending concurrently on a patent, and an order granting reexamination has been issued for the reexamination proceeding, *the files for the reissue application and the reexamination will be forwarded to the Office of Patent Legal Administration (OPLA) for a decision whether to merge the reissue and the reexamination, or stay one of the two.*” (Emphasis added). *SoF 16.*

MPEP § 1449.01 (Eighth Edition, Rev. 5, August 2006 & Rev. 6, September 2007) instructed that when “[w]here a reissue application and a reexamination proceeding are pending concurrently on a patent, *and an order granting reexamination has been issued* for the reexamination proceeding, the Office of Patent Legal Administration (OPLA) must be notified that the proceedings are ready for a decision as to whether to merge the reissue and the reexamination, or stay one of the two.” *SoF 17.*

The Office knew of the ‘102 reexamination application during the copending period. *SoF 18.* MPEP § 1449.01 (Eighth Edition, Rev. 2, May 2004) instructed, for example, that when “[w]here a reissue application and a reexamination proceeding are pending

concurrently on a patent, the patent owner, i.e., the reissue applicant, has a responsibility to notify the Office of the concurrent proceeding. 37 CFR § 1.178(b), 37 CFR 1.565(a), and 37 CFR 1.985(a).” *SoF 19*. During the copending period, and specifically on October 28, 2004, the patent owner notified the Office of the concurrent ‘102 reexamination application, via a Supplemental Information Disclosure Statement (*Ex. B*). *SoF 20*.

Yet despite knowing of the copending ‘102 reexamination application, there is no indication in the file wrapper of the instant application or that of the copending ‘069 application that the OPLA was notified by the examiner for a decision on whether to merge these cases with the ‘102 reexamination application, as required by MPEP § 1449.01 (Eighth Edition, Rev. 2, May 2004). *SoF 21*.

During the prosecution of the ‘102 reexamination application, the Office did not act as though the claims in the above-captioned application or the other ‘069 application would be estopped or considered as potentially surrendered based on the prosecution of the claims in the ‘102 reexamination application. *SoF 22*. The Office did not merge or stay the prosecution of either the present application or the copending ‘069 application with that of the ‘102 reexamination application. *SoF 23*. Further, the Office did not order the reissue patent applicant/patent owner to place and maintain in a single application all claims that may have been pending in the other two applications (as there was no merged proceeding). Cf. 37 CFR §1.565(d). *SoF 24*.

Instead, the Office continued with separate prosecution of the instant application during the copending period, issuing a final office action, on April 12, 2005 and a non-final office action (after filing of an RCE), on June 21, 2006. *SoF 25*. Such actions are in contravention to MPEP §1149.01(a). See, *SoF 12, Ex. A*.

In short, the guidelines of MPEP § 1449.01(B) did not exist during the copending period. *SoF 26*. And the guidelines of MPEP § 1449.01(B) were not followed during the copending period. *SoF 27*.

Moreover, the claims in the ‘102 reexamination application were not the same as those pending in the instant application or those in the copending ‘069 application. *SoF 28*. Claims having the same scope as those of the instant application (or that of the copending ‘069 application) were not canceled during the ‘102 reexamination application. *SoF 29*. The

claims of the instant application (and that of the copending '069 application) are different from the claims prosecuted in the '102 reexamination application. *SoF 30.*

The Patent Owner did file a terminal disclaimer in the above-captioned case, disclaiming any patent term beyond that of RE 37,585, which is the separate reissue application upon which the '102 reexamination application was filed. That terminal disclaimer, however, was filed on January 28, 2003, before the grant (and filing) of the '102 reexamination application. *SoF 31.*

The Office has never issued an double patenting rejection between the claims of RE37,585 F1 and those of the instant application. *SoF 32.* The only doubling patenting rejection in the file wrapper came after completion of the '102 reexamination application; and that double patenting rejection was between the instant application and the copending '069 application. *SoF 33.*

MPEP § 1449.01(B) does not govern the instant application. No surrender or estoppel exists between the non-merged and non-stayed '102 reexamination application and the instant application, under in MPEP 1449.01(B) or otherwise. (*SoF 34.*)

The use of MPEP 1449.01(B) to reject the claims under 35 U.S.C. § 251 is procedurally improper. *SoF 35.*

IV. Conclusion

Applicant asks that the Director suspend and/or waive the guidelines of MPEP 1449.01(B) as not applicable to the instant application, and that such decision be provided to the examiner and placed in the file wrapper.

If the Director has any questions, please feel free to contact the below-signed representative.

Dated: April 12, 2013

Respectfully submitted,

Electronic signature: /Paul B. Stephens/

Paul B. Stephens

Registration No.: 47,970

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive

6300 Willis Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant